Office Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1963.

No. 618

GENERAL MOTORS CORPORATION, METAL LUBRICANTS CO., HOUDAILLE INDUSTRIES, INC.,
Petitioners,

vs.

DEVEX CORPORATION, WILLIAM C. McCOY, THEODORE A. TeGROTENHUIS.
Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

Petitioners pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit entered in the above entitled case on July 12, 1963.

Record references used herein:

Pl. App. means—Appendix to Brief for Plaintiff-Appellant in the Court of Appeals.

Def. App. means—Appendix to Brief for Defendants-Appellees in the Court of Appeals.

Pet. App. means—this Petition.

CITATIONS TO THE OPINIONS BELOW

The opinion of the Court of Appeals is reported in 321 F. 2d 234.

The opinion of the United States District Court for the Northern District of Illinois has not been published in the Reports. It appears in the Appendix to Brief for Plaintiff-Appellant in the Court of Appeals, pp. 117-139, and Findings of Fact and Conclusions of Law of the District Court at pp. 140-172 of the same appendix. The opinion of the Court of Appeals, reversing the District Court, appears at the end of this Petition, pp. 2-33.

STATUTES INVOLVED

The statutory provisions involved are: Sec. 102(a) and (f) of U. S. C. Title 35, Sec. 103, Sec. 112 of U. S. C. Title 35 and Sec. 111 and 115 of U. S. C. Title 35, printed at the end of this Petition, pp. 34-37.

JURISDICTION

The judgment of the Court of Appeals was entered on July 12, 1963. Rehearing was denied on September 4, 1963. Jurisdiction of this Court is invoked under 28 U. S. C. Sec. 1254(1).

QUESTIONS PRESENTED

1. Where motion for new trial under Rule 59 of the Rules of Civil Procedure, based on hearsay affidavit concerning alleged newly discovered facts not in evidence, is denied in the District Court, can the Court of Appeals consider the same as evidence supporting its reversal of final judgment of the District Court without affording the

opposing party its day in court to explain, deny or rebut such alleged evidence as contemplated by Rule 59.

2. Is a broadly worded patent claim for a process which does not specifically identify either the materials or quantities thereof required for operation of the process invalid for failure to comply with 35 United States Code, Sec. 112, which provides:

> "* * * The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention".

where uncontroverted evidence shows that with materials contended to be included within the broad terminology of the patent claim but not specifically identified therein, the process operates in a manner and with a result directly contrary to the process the alleged inventor and patentee testified that he conceived and made and disclosed in the patent.

3. Where the alleged inventor and patentee admits that a process within the broad terminology of his claim was successfully performed and demonstrated to the knowledge and in the presence of himself and others without a pledge of secrecy prior to the date he relies upon for his invention and discovery of the patent claim

(a) is the patent to him for such claim invalid under 35 U. S. C. 111, which provides:

> "The application for the patent shall be made by the inventor, * * *".

(b) is the patent to him for such claim invalid under 35 U. S. C. 115, which provides:

> "The applicant shall make oath that he believes himself to be the original and first inventor of the process, * * * for which he solicits a patent; * * *"

(c) is the patent to him for such claim invalid under 35 U. S. C. Sec. 102, which provides:

> "That a person shall be entitled to a patent unless—
>
> "(a) the invention was known or used by others in this country, * * * before the invention thereof by the applicant for patent, * * *.
>
> "(f) he did not himself invent the subject matter sought to be patented, * * *."

4. Was the Constitutional standard for patentable invention established by this Court met and satisfied by Claim 4 of the patent in suit, in view of 35 U. S. C. 103, where the only difference between the claim and the known processes of the prior art in public use was to substitute for a lubricant film of oil or fat or grease or soap on the phosphate coated steel, the Drawcote soap-borax lubricant of the prior art. The prior art clearly disclosed, and taught that increased efficiency in cold drawing steel was obtained when the surface of the steel was provided with a lubricated phosphate coating, as compared with omitting the phosphate coating and applying lubricant directly to the surface of the steel, by lengthening the life of drawing tools, reducing friction, increasing drawing speeds and reducing the number of drawing operations. The prior art also clearly disclosed and taught that increased efficiency in cold drawing steel was obtained with Drawcote soap-borax lubricant applied as a fixed (dried on) film to the surface of the steel, in place of oil or fat or grease or soap lubricants, by providing a glass-forming lubricant that would increase die life and enable greater reductions to be made.

STATEMENT

Respondents here, plaintiffs below, started two suits in the United States District Court for the Northern District of Illinois for alleged infringement of United States Letters Patent Re. 24,017. (Pl. App. pp. 1-31.)

Civil Action No. 56 C 1912 was started on November 13, 1956 against General Motors Corporation and Metal Lubricants Co., defendants below—petitioners here.

Civil Action No. 57 C 892 was started on May 17, 1957 against Houdaille Industries, Inc., defendant below—petitioner here.

General Motors Corporation and Metal Lubricants Co., defendants in Civil Action No. 56 C 1912, are unrelated to Houdaille Industries, Inc., the defendant in Civil Action No. 57 C 892.

On motion of the plaintiffs, opposed by defendants, the District Court consolidated the separate suits Nos. 56 C 1912 and 57 C 892 for trial of the sole common issue of the validity of Claim 4 of the patent Re. 24,017. The District Court Order of Consolidation (Pet. App. pp. 39-40) consolidated the actions for trial of the common issue of validity of Claim 4 but not otherwise, and provided that the common issue be tried first, that all issues of infringement, including the defense of improper venue and consequent lack of jurisdiction as to General Motors Corporation (Par. 11 General Motors Answer, Pl. App. p. 20) be tried subsequently and separately, and which have not yet been tried and determined.

The consolidated trial of the common issue of the validity of Claim 4 of patent Re. 24,017 was had January 30 through February 6, 1961. Plaintiffs and defendants were instructed to and did submit simultaneously suggested findings of fact and conclusions of law and briefs.

Subsequently, on February 1, 1962, the District Court filed its decision (Pl. App. pp. 117-139) on the common issue, holding Claim 4 invalid and void. Thereafter, on June 29, 1962, the District Court entered findings of fact and conclusions of law and judgment (Pl. App. pp. 140-174), finding Claim 4 of the patent invalid and void and dismissing the complaints in both actions 59 C 1912 and 57 C 892, and on the same date plaintiffs filed an affidavit in support of motions to amend findings of fact and to grant new trial (Pl. App. pp. 175-182), alleging newly discovered evidence. On July 13, 1962 the District Court, holding plaintiffs had not shown due diligence with respect to the alleged newly discovered evidence, denied plaintiffs' motions to amend findings of fact and to grant new trial (Def. App. p. 172).

On August 10, 1962 plaintiffs filed a Notice of Appeal from the judgment of the District Court to the United States Court of Appeals for the Seventh Circuit.

On July 12, 1963 the Court of Appeals for the Seventh Circuit, after briefs by the respective parties and hearing, filed its decision reversing the District Court, holding Claim 4 of the patent Re. 24,017 valid (Pet. App. pp. 25-37). Petition for Rehearing, timely filed by the appellees (petitioners here) on July 26, 1963, was denied by the Court of Appeals on September 4, 1963 (Pet. App. p. 38).

The patent in suit, Re. 24,017 (Pl. App. pp. 71-80), relates to cold drawing and deforming ferrous metal (steel) to desired shape and dimension with drawing and deforming dies and the use of lubricant applied to the steel to reduce friction between the die and the surface of the steel and prevent the work and dies from scoring or galling each other as the deforming operation exerts pressure and devolops heat.

This is an old and well-known art; methods and materials

for lubricating die and work for the same purpose in such drawing and deforming operations have long been known and used (Dist. Ct. Findings of Fact Nos. 5, 6, 7, 8, 9, and 10, Pl. App. pp. 143-155).

Claim 4 of the patent in suit, the validity of which is the sole issue in this case, defines the alleged invention as follows:

> "4. The process of working ferrous metal which comprises forming on the surface of the metal a phosphate coating and superimposing thereon a fixed film of a composition comprising a solid meltable organic binding material containing distributed therethrough a solid inorganic compound meltable at a temperature below the melting point of the ferrous metal phosphate of said coating and having a hardness not exceeding 5 on the Mohs' hardness scale, and thereafter deforming the metal."

Respondents contend that Claim 4, which does not specifically so state, is valid to reach and include among other practices, the practice of providing the surface of the steel to be deformed with a *zinc phosphate* coating, superimposing on that phosphate coating a fixed film of *sodium-tallow soap and borax* as a lubricant, and thereafter deforming the steel. The sodium-tallow soap and borax is applied to the phosphate coating on the steel in a hot water solution or emulsion and then dried thereon until it is a fixed film, after which the steel is drawn or deformed in the dies.

The language of Claim 4, "a solid, meltable organic binding material", is contended to include sodium-tallow soap, and the claim language, "a solid inorganic compound", is contended to include borax which is mixed with the sodium-tallow soap and to have "a hardness not exceeding 5 on Mohs' hardness scales", which means that it is not hard enough to scratch the steel being deformed.

Respondents (plaintiffs-appellants below) rely upon the date of April 29, 1946 as the date of first invention and discovery of the process of Claim 4 by Henricks, the alleged inventor and applicant for the patent (Dist. Ct. Finding of Fact No. 16, Pl. App. p. 160).

Prior to the date relied upon for invention of Claim 4 of the patent in suit it was known in the prior art, and in public use, to provide the surface of steel to be drawn or deformed with a phosphate coating, and to apply a film of lubricant (oil or fat or grease or soap) to that phosphate coating, and then to deform steel, and that this was a definite improvement and aid in drawing and deforming steel in that it permitted deep and severe reduction rates; resulted in lengthening the life of drawing tools, reducing friction in the forming process, increasing reduction in drawing speeds and reducing the number of drawing operations. (Dist. Ct. Findings of Fact Nos. 6 and 7, Pl. App. 146-150).

Prior to the date relied upon for invention of Claim 4 it was known in the prior art, and in public use, to provide the surface of bare (uncoated) steel with a fixed film of sodium-tallow soap and borax as a lubricant (known by the trade name "Drawcote") and then to deform the steel, and that this lubricant would in use provide glassy materials as an essential and significant element of lubrication, substantially improving drawing operations and substantially increasing the life of drawing dies (Dist. Ct. Findings of Fact Nos. 8 and 9, Pl. App. pp. 150-154).

The sodium-tallow soap and borax lubricant recommended in the specification of the patent in suit for application to phosphate coated steel is the same Drawcote that was in public use as a drawing lubricant upon bare uncoated steel prior to the date (April, 1946) relied upon for the alleged invention and discovery of the process of Claim 4 of the patent in suit. The Drawcote is applied

and used upon zinc phosphate coated steel in the same way it was applied and used upon the bare, uncoated steel (Dist. Ct. Findings of Fact Nos. 4, 8, 10, Pl. App. pp. 140-142, 150-151, 154-155).

In 1942 and 1943 and subsequently, Gilron Products Company of Cleveland, Ohio (not party to this suit), manufactured and sold extensively the soap-borax lubricant under the trade name Drawcote for use in the drawing and deforming of steel.

Henricks, the alleged inventor and patentee of the patent in suit, was an employee of Gilron Products Company during the years 1942-1945 and fully aware of the sale and public use of Gilron Products Company Drawcote soap-borax lubricants in drawing and deforming steel during those years. Henricks left the employ of Gilron Products Company in 1945 and thereafter filed his original application for the patent in suit on April 29, 1946 (Dist. Ct. Findings of Fact Nos. 8, 9 and 10, Pl. App. pp. 150-155).

In 1943 Briggs Manufacturing Company at Detroit, Michigan, bought and used the Gilron Products Company Drawcote soap-borax lubricant in drawing and deforming steel to make 75 mm. shell cases for the Government, and used it as a lubricant in drawing and deforming steel when applied as a fixed film to zinc phosphate coated steel and also when applied as a fixed film to bare steel without any phosphate coating.

Henricks, alleged inventor and patentee of the patent in suit, in 1943 witnessed and knew of this use at Briggs Manufacturing Company.

Henricks testified (Def. App. pp. 5-6), that in June, 1943 Briggs Manufacturing Company was drawing steel shell cases for the Government to which they were applying a sulphurized grease over a zinc phosphate coating. That when Gilron Products Company came to Briggs

Manufacturing Company in about June, 1943 with its Drawcote soap-borax lubricant, they ran some blanks with the phosphate undercoat. That they applied the soap-borax lubricant first over the phosphate coating which had been applied to the steel blanks. That Briggs was in production on the phosphate coating and grease application at the time Gilron Products came in, and they used that as a safety factor in starting off until they were fully satisfied that they could draw without the phosphate undercoat as well as with it. That what they did was to substitute the soap-borax lubricant for the grease they had been previously using and applied it to the phosphate coating on the blank. That it was a successful operation. That shell cases they drew at Briggs with the soap-borax lubricant—both those where they applied the lubricant over the phosphate coating and also where they applied the lubricant over plain steel without the phosphate coating—were acceptable shell cases. That (Def. App. pp. 75-76) a few baskets of phosphate coated shell cases were drawn with Gilron Products soap-borax lubricant applied to the phosphate coating, and these were drawn successfully. That he was aware at that time that the Gilron Drawcote would work over a phosphate coating. That the drawing per se was satisfactory.

Tousley, whom Henricks identifies as the Briggs Manufacturing Company engineer in charge, and to whom Whitbeck (since deceased) of Gilron Products Company and Henricks reported and under whom they worked, corroborated Henricks' testimony, and also testified that they used the Drawcote over the phosphate coating at Briggs Manufacturing Company until they found they were able to use the Drawcote on the bare steel without the phosphate coating and speed up operations (Pl. App. pp. 70b, 70h, 70i, 70j, 70k, 70l, 70p, 70q and 70ff. Dist. Ct. Findings of Fact Nos. 14 through 20, Pl. App. pp. 158-163).

There is no evidence that any further experiment was necessary or required, after the Briggs Manufacturing Company use in 1943, to successfully perform and utilize the process defined in Claim 4 of the patent in suit by applying the Drawcote soap-borax lubricant as a fixed film to zinc phosphate coated steel and thereafter deform the steel (Dist. Ct. Finding of Fact No. 26, Pl. App. p. 167).

Claim 4 of the patent in suit does not state or otherwise specify the amount of inorganic compound (borax) to be included in the organic binding material (soap). Henricks, the alleged inventor and patentee, testified that to apply soap alone to zinc phosphate coating was not his invention (Def. App. 86). Plaintiffs refused to state the amount of borax required to be present in the soap to be within the scope of Claim 4. Henricks' testimony left the question wholly indeterminate and indefinite (Dist. Ct. Finding of Fact No. 28, Pl. App. p. 168). Henricks testified that his invention required enough borax in the soap to prevent the formation of water-insoluble soap on the phosphate coating (Def. App. pp. 87-96, 100-102). The uncontroverted evidence (Def. App. pp. 138-156) is that the inclusion in sodium soap of a small amount of borax (approximately 3% of the soap) results in forming as the lubricant on the zinc phosphate coating of water-insoluble soap (zinc stearate) as an integral part of the zinc phosphate coating, not disclosed in the patent in suit and directly contrary to Henricks' statement of his concept, alleged invention and purpose. Claim 4 is thus so indefinite as to cover matter directly contrary to the alleged invention (Dist. Ct. Finding of Fact No. 29, Pl. App. p. 170).

Prior to the patent in suit, Gilfon Products Company obtained patents for its Drawcote soap-borax lubricants (Dist. Ct. Findings of Fact 9 and 10, Pl. App. pp. 152-155), none of which belong to respondents and none of which

are at issue in this suit, namely: U. S. patent No. 2,469,473, application filed August 2, 1943, patent granted May 10, 1949—for the process of cold working metal employing such lubricants (Pl. App. p. 81); U. S. patent No. 2,530,837, original application filed August 2, 1943, patent granted November 21, 1950—for the composition of such lubricants (Def. App. p. 173); and U. S. patent No. 2,470,062, original application filed October 27, 1945 (Pat. Col. 5, line 60, Pl. App. p. 90), continuation-in-part application filed October 8, 1948, patent granted May 10, 1949—for the composition of such lubricants and for blank metal stock coated with such lubricants (Pl. App. p. 88). Respondents, with the broad and indefinite terminology of Claim 4 of the patent in suit, now claim a fourth patent monopoly upon the same lubricants for a use not only admittedly known to Henricks the alleged inventor of the patent in suit and others prior to the date of invention and discovery respondents assert for Claim 4 of the patent in suit, but also clearly suggested by and obvious from the prior art.

Respondent's motion for new trial under Rule 59 F. R. C. P., denied in the District Court (Def. App. p. 172), alleges by affidavit of Henricks (Pl. App. pp. 175-177) discovery of a report by Briggs Manufacturing Company to the Ordnance Department after completion of the 75 mm. steel shell case manufacturing operation in 1943, that the report shows that Drawcote soap-borax lubricant applied to bare steel was finally adopted and used in the Briggs Manufacturing Company shell case manufacturing operation, and that, in Henricks' opinion, because the report does not state that zinc phosphate coated steel with the Drawcote soap-borax lubricant applied thereto was successfully drawn and deformed during the course of the operation, it is proof that this was never done. This is directly and conclusively refuted by the facts explicitly admitted by respondents, i.e. (Dist. Ct. Finding of Fact

No. 17, Pl. App. 161-162), and the testimony of Henricks himself (Def. App. pp. 5-6, 74-76)—who witnessed if and explicitly testified that at Briggs Manufacturing Company in 1943 zinc phosphate coated steel with Drawcote soap-borax lubricant applied thereto was successfully drawn and deformed, and this is confirmed by the testimony of Briggs Manufacturing Company engineer Tousley (Pl. App. pp. 70b, 70h, 70i, 70j, 70k, 70l, 70p, 70q, and 70ff), identified by Henricks as present in charge of and familiar with the work at the time.

REASONS FOR GRANTING THE WRIT.

Petitioners believe the writ of certiorari should be granted in this case for the following reasons:

It is of paramount public importance that the basic and fundamental requirements of the Patent Act (35 U. S. C.) for the grant of patents, and the Constitutional standard of invention established by the decisions of this Court as essential to justify and sustain the grant of patents under the Patent Act, continue to be observed, and not nullified in the lower Courts as the Court of Appeals, conflicting with the District Court, has done in this case.

It is believed that the case at bar presents questions of judicial application and interpretation of the Patent Laws, of public importance as great as those entertained and decided by this Court in the following cases where, as in the case at bar, there was no conflict between different Courts of Appeal.

Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147-158, certiorari granted for resolution of the issue of whether a Court of Appeals and the District Court concurring below had applied the correct criteria and Constitutional standard of invention to patent claims for combinations of old elements.

Graver Tank & Mfg. Co. v. *Linde Air Products Co.*, 336 U. S. 271-281, certiorari granted for review of the interpretation and application by the Court of Appeals and the District Court below, of the statute—then 35 U. S. C. 33, now amended 35 U. S. C. 112—requiring that patent claims shall particularly point out and distinctly claim what the inventor and applicant for the invention claims as his invention or discovery.

Funk Bros. Seed Co. v. *Kalo Inoculant Co.*, 333 U. S. 127-138, certiorari granted for review of conflicting decisions of the Court of Appeals and the District Court below on the question of whether combination patent claims involving discovery or application of a phenomenon of nature satisfied the statutory requirement of invention or discovery.

With respect to Question 1 presented (p. 2, Statement p. 12), the Court of Appeals in its Opinion (p. 10, 2d and 3rd paragraphs, Pet. App. p. 36) considered as material evidence in its reversal of the District Court, Henricks' affidavit of alleged newly discovered evidence attached to Respondent's Motion for New Trial in the District Court, which was denied by the District Court without receiving such matter as evidence in the case. If the Court of Appeals believed that the evidence shown in the Henricks affidavit was material to the issues and that the District Court should have granted a new trial, the most the Court of Appeals should have done was to remand the case to the District Court for further proceedings on the issue of validity. But it should not have ignored Rule 59 F. R. C. P. and unqualifiedly accepted that evidence as true and proven and then used that evidence as a basis for reversal. The affidavit was pure hearsay and of no evidentiary value whatsoever. This unprecedented action by the Court of Appeals, if condoned by the Supreme Court of the United States and allowed to stand, would make a sham of all Dis-

trict Court trials, the trial records and the findings of fact and conclusions of law of the trial judge. It would mean that a litigant after a case had been tried and finally decided in the District Court could by a simple hearsay affidavit present further unproven evidence for consideration by a Court of Appeals and that the Court of Appeals would have the right and power to consider that evidence and reverse the trial court. A patent monopoly would be established without a full court hearing of all the evidence.

Thus, the Court of Appeals has thereby denied petitioners their day in court to explain, deny or rebut matter considered by it as material evidence but which is not evidence in the case. This is such a clear departure from the accepted and usual course of judicial proceedings, which is to consider only evidence of record with respect to which the opposing party has had its full day in court, as to call for exercise of this Court's power of supervision directing the Court of Appeals to vacate its decision and remand to the District Court for new trial.

Phelan v. *Middle States Oil Corp., et al.*, 210 F. 2d 360, 361, 366 (C. A. 2, 1954).

With respect to Question 2 presented (pp. 2-3, Statement pp. 10-11), the Court of Appeals, in reversing the District Court for error in holding patent Claim 4 invalid under 35 U. S. C. Sec. 112 for failing to particularly point out and distinctly claim subject matter which the patentee has testified that he regards as his invention (Dist. Ct. Finding of Fact No. 29, Conclusion of Law 1(e), Pl. App. pp. 170-171), is in conflict with the applicable decisions of this Court.

The decisions of this Court hold and require that strict compliance with this statutory provision is essential to the validity of patent claims.

General Electric Company v. *Wabash Appliance Corporation*, 304 U. S. 364, 369. *United Carbon Company* v.

Binney & Smith Company, 317 U. S. 228, 236, 237. *Graver Tank & Manufacturing Company, Inc., et al.* v. *Linde Air Products Company*, 336 U. S. 271, 276-279. *Holland Furniture Company* v. *Perkins Glue Company*, 277 U. S. 245, 257. *The Incandescent Lamp Patent*, 159 U. S. 465, 474-475. *O'Reilly et al.* v. *Morse et al.*; 15 Howard 62, 113, 119-120.

In the case at bar, as shown in the Statement herein (pp. 10 and 11), patent Claim 4 in issue does not particularly point out and distinctly claim the subject matter which the applicant testified that he regarded as his invention, but is so indefinite as to cover subject matter directly contrary thereto.

The controlling essential of the matter is that the applicant testified that what he regarded as his invention was to employ borax in the soap in amounts or proportions that would inhibit and prevent the formation of water-insoluble soap films on the phosphate coating, which depends upon the amount or proportion of borax employed with the soap. The claim is broadly drawn to include all proportions of borax to soap. Uncontroverted evidence shows that 3% borax in the soap can and does result in forming water-insoluble soap (zinc stearate) on the zinc phosphate coating, directly contrary to what applicant regards as his invention.

The Court of Appeals (Opinion p. 4, last paragraph, and p. 5, 3rd and 4th paragraphs, Pet. App. pp. 29-30) recognizes it to be an essential feature of the applicant Henricks' process invention, both as a distinction from prior art, which formed a water-insoluble soap film on the phosphated workpiece, and as a new and unexpected result justifying patentability and grant of the patent claim, that with Henricks' process the *formation of insoluble organic materials or compounds is inhibited*. This is clear recognition that the claim, which broadly covers all proportions and amounts of borax and soap is so indefinite and broad as to cover

subject matter directly contrary to that which the applicant regards as his invention, and is therefore invalid for failure to comply with the requirement of Sec. 112.

With respect to Questions 3 and 4 presented (pp. 3-4 and Statement, pp. 7-12), the controlling consideration is that it is plain and clear under the sections of the Patent Act referred to, that a valid patent cannot be granted on the application of a person who is not the inventor (35 U. S. C. 102(a) and (f), 111, 115), nor for aggregation of segments of the prior art, in which each segment obviously continues to perform the same function with the same result for which it was already well known and employed in the prior art.

Claim 4, as asserted in this case, is simply to provide a phosphate coating on the surface of the steel, superimpose a fixed film of soap and borax thereon and thereafter deform the steel. Nothing other or further in the way of function or manner of operation or result is required.

Respondents assert and rely upon invention and discovery of that subject matter of the patent Claim 4 in 1946, long after it was admittedly already known that it had been successfully used and demonstrated at Briggs Manufacturing Company in 1943 in the usual and ordinary course of the sale of Drawcote soap-borax lubricant by its producer Gitron Products Company to Briggs Manufacturing Company to replace the use of sulphurized grease on zinc phophate coated steel which Briggs had been and was then using. In the normal, natural and ordinary course of business in promoting and selling and demonstrating the uses of Drawcote at Briggs, it was shown and demonstrated that Drawcote could be used on the phosphate coated steel in the place of sulphurized grease, and that it could also be used when applied directly to the steel without the phosphate coating.

It is incontrovertible that Drawcote was and is applied

and used on phosphate coated steel the same way it was applied and used on bare steel before the alleged invention of the patent in suit, by applying it as a hot aqueous solution or emulsion, then drying it to a fixed film on the surface of the work and thereafter deforming the metal.

It is incontrovertible that Drawcote was known before the alleged invention of the patent in suit to provide a glassy lubricating compound having highly effective lubricating properties that increased die life, enabled more difficult reductions in drawing, and left residues readily removable in water, which the Court of Appeals (Opinion p. 5, Pet. App. p. 27) erroneously assumes to be a new and unexpected result when applied to phosphate coating. This is clearly disclosed and taught in the prior Gilron patent No. 2,469,473 (Pl. App. p. 81), patent application filed August 2, 1943, covering the Drawcote soap-borax lubricant in public use in 1943. The specification of this patent, and the application on which it was granted, expressly disclose and teach that this lubricant provided a glassy compound (patent specification col. 4, line 11 et seq., line 73 et seq.; col. 6, line 6 et seq., line 20 et seq., line 39 et seq.). Col. 6, line 72 through line 3 of col. 7 explicitly teaches that such lubricant leaves residues on the work readily removed in water. Col. 8, line 72 through line 11 of col. 9 explicitly states that this lubricant was known to increase die life and enable more difficult draws to be made. In cols. 12 and 13, Claim 1 specifies the use of "a plurality of dried inorganic hydrated glass forming materials * * *"; Claim 2 specifies the application of materials to the stock to be drawn or deformed "in the form of a dry self-adherent homogeneous film"; and Claim 4 specifies that the "organic material is a high titre soap and at least one of the dry inorganic materials is borax."

It is incontrovertible that the prior Singer patents and German publications (Dist. Ct. Finding of Fact No. 6, Pl.

App. pp. 146-149) disclose and teach that the use of lubricated phosphate coatings on steel were known processes to aid and improve cold drawing steel by permitting deeper and more severe reduction rates, reduced friction, increased drawing speeds and reduced the number of drawing operations (Dist. Ct. Finding of Fact No. 6, Pl. App. pp. 146-149); and (Dist. Ct. Finding of Fact No. 23, Pl. App. p. 166) that the function of the phosphate coating was to provide barrier material to separate the drawing die from the work and prevent scoring and galling, and to provide a surface for retaining in place the lubricant applied to it.

It is plainly apparent and incontrovertible that the process Claim 4 calls for no more than an aggregation of the known segments of the prior art, namely phosphate coatings and Drawcote. That each contributes its known function—the phosphate coating to provide barrier material to separate the drawing die from the work and a surface to retain the lubricant in place—and the Drawcote to provide its known glassy compound having highly effective lubricating properties.

Claim 4 does not require, nor does the specification of the patent teach or disclose, that the soap-borax and phosphate coact to form new compounds during the drawing process (Dist. Ct. Finding of Fact No. 12, Pl. App. p. 156). All matter concerning this subject was cancelled from the application for the patent before it was granted (Dist. Ct. Finding of Fact No. 13, Pl. App. pp. 156-158). Respondents, claiming X-ray diffraction tests indicated new compounds were formed, admitted that no quantitative values or amounts could be determined from the tests. There was no evidence that the compounds alleged to be present in the samples tested were present in any significant quantity or had any controlling or significant effect in

the drawing operations (Dist. Ct. Findings of Fact Nos. 11 and 12, Pl. App. pp. 155-156).

In this state of the prior art, which the alleged inventor is presumed to know, and which he actually did know, it is plain and clear that he did not invent or discover anything. He merely assembled in one process well known segments of the prior art, each of which was employed in the same manner it was employed in the prior art and each of which contributed the same function and result for which it was known and used in the prior art and plainly to be expected and not surprising.

In these circumstances, to hold the subject matter of Claim 4 to be patentable invention, and Henricks an inventor entitled under the Patent Act to a patent for it, as the Court of Appeals has done in this case, is a plain and clear disregard of the fundamental criteria and Constitutional standard of invention, in direct conflict with the applicable decisions of this Court, and requires action by this Court in the public interest to compel the continued observance in the lower Courts of the fundamental requirements essential to justify and sustain patent monopolies under Constitution and the Patent Act.

Great Atlantic & Pacific Tea Company v. *Supermarket Equipment Corporation*, 340 U. S. 147, 152-153. *Mandel Bros., Inc.* v. *Wallace*, 335 U. S. 291, 296. *Sinclair & Carroll Co.* v. *Interchemical Corp.*, 325 U. S. 327, 334-335. *Dow Chemical Co.* v. *Halliburton Oil Well Cementing Co.*, 324 U. S. 320, 327, 330. *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 88-92. *Altoona Publix Theaters* v. *American Tri-Ergon Corp.*, 294 U. S. 477, 486. *Hollister* v. *Benedict & Burnham Manufacturing Company*, 113 U. S. 59, 73. *Smith* v. *Nichols*, 88 U. S. (21 Wall.) 112, 119. *Hotchkiss et al.* v. *Greenwood et al.*, 11 Howard 247, 266.

CONCLUSION.

For the foregoing reasons, this petition for writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX.

Statutes Involved.

UNITED STATES CODE TITLE 35—PATENTS.

SECTION 112. *Specification.*

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

"* * *"

SECTION 111. *Application for patent.*

"Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. * * *"

SECTION 115. *Oath of applicant.*

"The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; * * *"

SECTION 102. *Conditions for patentability; novelty and loss of right to patent.*

"A person shall be entitled to a patent unless—

"(a) the invention was known or used by others

in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

* * *

"(f) he did not himself invent the subject matter sought to be patented, or

* * * *"

SECTION 103. *Conditions for patentability; non-obvious subject matter.*

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *."

IN THE UNITED STATES COURT OF APPEALS

For the Seventh Circuit.

No. 13979 SEPTEMBER TERM 1962—APRIL SESSION 1963

DEVEX CORPORATION *et al.*, *Plaintiffs-Appellants*, v. GENERAL MOTORS CORPORATION *et al.*, *Defendants-Appellees*. | Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

July 12, 1963

Before DUFFY and SWYGERT, *Circuit Judges*, and MAJOR, *Senior Circuit Judge*.

DUFFY, *Circuit Judge*. These are two civil suits for infringement of Henricks' Reissue Patent No. 24,017 which were consolidated for trial on the common issue of validity. Claim 4 is the only claim at issue.[1] The District Court held Claim 4 of the patent in suit to be invalid in view of the indefiniteness of the claim, the prior art and prior public use.

[1] Claim 4 reads:

"4. The process of working ferrous metal which comprises forming on the surface of the metal a phosphate coating and superimposing thereon a fixed film of a composition comprising a solid meltable organic binding material containing distributed therethrough a solid inorganic compound meltable at a temperature below the melting point of the ferrous metal phosphate of said coating and having a hardness not exceeding 5 on the Mohs' hardness scale, and thereafter deforming the metal."

The patent in suit relates to lubrication of metal surfaces in cold drawing and deforming operations in shaping steel to desired forms by dies, to reduce friction between the steel workpiece being drawn or shaped and the die, to avoid scoring and tearing of the metal being drawn and to avoid injury to the surface of the dies.

The patent in suit is the outcome of an application, Serial No. 665,905, filed April 29, 1946 by the patentee Henricks, which was abandoned in favor of a continuation-in-part application filed October 31, 1950, upon which was issued United States Patent No. 2,588,234, dated March 4, 1952, for which application for reissue was filed March 1, 1954, upon which Re. Patent No. 24,017 now in suit issued on June 7, 1955.

Claim 4, the only claim in issue, is identical to Claim 45 as allowed by the Patent Office in the 1946 application. April 29, 1946, the date when the 1946 application was filed, is therefore the record date of invention to which the patentee is entitled.

The patent in suit relates particularly to the lubrication of metal for drawing and forming operations. It concerns cold forming operations as opposed to hot forming operations. When metal is drawn or deformed, to transform a blank or workpiece into another desired shape, there is necessarily some movement between the surface of the blank and the surface of the die, and an accompanying generation of high pressures and temperatures. Adequate lubrication is essential. Unless suitable provision for lubricating the surfaces is made, tearing of the metal or galling of the dies results. The problem is most acute where difficult draws of ferrous metals are involved. Drawing operations require costly tools and dies. It follows that wear and abrasion are very important considerations in tool and die work.

Among the suggestions contained in the patent in suit is that of providing upon the surface of the work to be drawn, an integral phosphate coating and applying thereto a film of sodium tallow soap having borax distributed therein. It is contended that a solid meltable organic binding material mentioned in Claim 4 includes sodium tallow soap and that a solid inorganic compound mentioned in the claim includes borax.

Mohs' hardness scale is a known standard for indicating the relative hardness of materials. It is used in Claim 4 as a specification that the "solid inorganic compound" of the claim should not be hard enough to scratch the steel being drawn.

The prior art disclosed a number of lubricating schemes. These included the use of ordinary lubricating oils or lubricants containing finely divided infusible pigments such as clay, lime, mica or graphite. Most of such schemes were classified as "wet film" lubricants which were wet and oily to the touch.

Later followed what is known as Singer's process, evolved in Germany and described in Singer United States Patent No. 2,105,015. Singer's scheme was to form a sponge-like coating, such as a phosphate, on the surface of the workpiece. The coating was not wet or flowable but was integral with the workpiece and could not be squeezed out in the drawing operation.

Phosphate coatings had been in use as early as 1914. These coatings had no lubricating value *per se*. They were, in fact, abrasive and caused tool and die wear even through superposed lubricants. The reason they were used in lubricating schemes was due to their ability to absorb and carry lubricant into a high pressure zone.

The next step forward in the art after the Singer process, was the development of the Gilron "Dry-Film" soap and borax lubricant. In this process, soap and borax were

mixed with water and applied as an aqueous solution to the surface of the workpiece. The soap and borax coating was then dried by heat lamps or the like onto the surface of the workpiece. As drawn, it was a hard fixed film and stayed with the workpiece in the high pressure zones. No other lubricant was used.

The Gilron soap-borax coating on bare metal being transparent, permitted inspection of the workpiece and eliminated the abrasive phosphate. The Gilron process supplanted the Singer process in the shell case program of the United States Government during World War II.

In 1942 and thereafter until 1945, Henricks, the patentee of the patent in suit, was employed by Gilron Products Company and was familiar with the uses of soap-borax lubricants described in patents No. 2,469,473 and 2,530,837. The Gilron lubricating product for use in drawing steel was sold under the tradename "Drawcote" and was composed principally of sodium soap formed from tallow and palm oil, and of borax in proportion by weight of 16.33% soap to 67.90% borax.

Drawcote was sold in the form of a dry powder. Gilron Products Company obtained patents on Drawcote and its use. United States Patents No. 2,469,473 dated May 10, 1949, and No. 2,530,837 dated November 29, 1950, were obtained upon the joint application of Gilbert H. Orozco, a partner of Gilron Products Company and his employee Henricks, the patentee of the patent in suit.

Drawcote was extensively sold and used in 1942 and 1943 in cold drawing of steel cartridge cases. In those years during World War II, there was a shortage of copper for making brass shell cases for the ammunition used in military and small arms weapons. The Government required manufacturers of shell cases to make them from steel by cold drawing and deforming. This manufacture of steel

shell cases occurred largely during the period 1942-1944, after which copper again became available.

In the manufacture of shell cases, Gilron's Drawcote was able to replace the use of other lubricants such as lubricated copper coatings for steel and lubricated phosphate coatings for steel.

In 1943, among those using a lubricated phosphate coating on steel in the operation of cold drawing steel 75 mm. shell cases, was Briggs Manufacturing Company, Detroit. That Company was then providing zinc phosphate coatings on steel blanks and applying thereover a sulphurized grease as a lubricant. About June 1943, Whitbeck of Gilron Products Company sold Drawcote to Briggs. By experimentation, Briggs found it could successfully carry out its cold drawing operation with the Drawcote soap-borax lubricant applied directly to the surface of the steel without the phosphate coating.

Plaintiffs admit the Gilron borax coating solved many drawing problems existing at that time and that even today, it is satisfactory for many draws. However, plaintiffs claim the process has its limitations and cannot do what the Henricks process does.

The Patent Office was fully advised of the nature and advantages of the Gilron process. Patent No. 2,469,473 was a file wrapper reference.

Several references are made in the briefs to the "German Process." This was developed prior to 1942. In this process, a phosphated workpiece is soaked as long as fifteen hours in an aqueous soap solution to form thereon, by chemical interaction between the phosphate and soap, a water-insoluble soap film. A serious defect in this scheme was that the residual deposit was not water soluble and presented a difficult cleaning problem especially if the workpiece was to be electroplated.

Plaintiffs concede all of the elements which Henricks employed in Claim 4 in the patent in suit were old *per se* or in other combinations and have been available in the art for some years. However, plaintiffs contend that the elements which Henricks selected were put together in a new way and achieved a new and unexpected result.

Plaintiffs claim that in the specific embodiment of Claim 4, the "phosphate coating" is the abrasive coating of the Singer process—a seeming retrogression in the art. The overlying film is a fixed one and the "solid meltable organic" constituent thereof is soap, the use of which had previously been found undesirable because of the cleaning problem. The "solid meltable inorganic compound" distributed therethrough, meltable at a temperature below the melting point of the abrasive phosphate coating and having a hardness not more than 5 on the Mohs' scale, is borax.

Plaintiffs argue that new and unexpected results flow from the conjunction of elements defined in the drawing process of the Henricks' patent; that tool and die life is greatly increased and severe drawing operations can now be performed which were previously impossible. Plaintiffs say there is a coaction during the high temperatures and pressures whereby the abrasive phosphate coating reacts with the borax to form amorphous glassy materials which contribute significantly to the lubricating value of the coating; that the formation of insoluble organic materials is inhibited and there is no cleaning problem.

There is substantial evidence in the record to prove that a new coaction between the soap, borax and phosphate occurred during the drawing process. Friedberg's tests showed that in the Henricks' process, new compounds are formed; the formation of insoluble organic compounds is inhibited, and the abrasive phosphate is transformed into

a glassy amorphous compound having highly effective lubricating properties.

There was also proof based upon commercial use and experience. Metal Forming & Coining Corporation tried a number of the prior art schemes including oils, waxes and drawing compounds, but the testimony showed that the only process that enabled this Company to cold form or coin small parts commercially is the combination in the Henricks' patent in suit. Testimony showed tool and die life was increased one thousand fold so that for given tools, three or four hundred thousand pieces were run where previously only three or four hundred pieces could be run. The Henricks' process made it possible to manufacture articles of superior quality at a much lower cost, the advantage being so marked in some cases as to spell the difference between success and failure on heavy reductions and difficult extrusions.

Defendants have engendered a great interest in an endeavor to have the Henricks' patent in suit declared invalid. The defense of this action has been conducted primarily by the attorneys for the Parker Rust Proof Company of Detroit. Parker supplies phosphate and lubricating materials to defendant General Motors, and is holding General Motors harmless. Parker solicited financial and legal help in this lawsuit from a number of its own competitors, and at least three of these competitors in manufacturing and selling phosphate and lubricating material, have given assistance in this case. Of course, these competitors had the right to give such assistance. However, such interest does indicate that the process covered in Claim 4 of the patent in suit is something of special value and merit and of great importance to those working in the field of cold drawing and deforming operations.

The trial court held Claim 4 too broad and lacking in specificity. The court stated the claim did not specify the

kind of phosphate coating, the kind of organic binding, the kind of solid inorganic compound, as well as not specifying the amounts and relative proportions of any such items.

Pertinent on this point is a recent case before this Court, *Binks Manufacturing Company* v. *Ransburg Electro-Coating Corporation*, 281 F. 2d 252. In that case, the claim was made that the method claims of the patent there in suit did not satisfy the requirements of the patent statute (35 U.S.C. § 112) due to failure to specify voltage, spacing and liquids to which they are applicable. In overruling this argument we said at page 256: "The process claims define the specific steps of procedure and the specifications being addressed to those skilled in the art . . . need not recite details." We further stated at page 257: "There is no requirement that quantitative values for such factors as voltage, spacing and liquid characteristics be recited. The fact that experimentation or the exercise of judgment is necessary to adapt a patented process to particular material or to obtain the particular results desired does not impair validity of the patent."

The fact that Claim 4 distinguishes from thirty-one references in a mature art, none of which anticipate, quite clearly establishes that the claim is not too broad and indefinite.

Patent claims should be generic in character and do not necessarily have to be specific. It is entirely proper to refer in Claim 4 to "a phosphate coating" without specifying which "phosphate coating."

The examples stated in the patent in suit and the specification teach the use of soap and borax over phosphate. They give formulas for the soap and borax and they identify the phosphate coating baths so that one skilled in the art could make them. The trial court was in error in

holding that Claim 4 in the patent in suit was too broad and lacking in specificity.

It is fundamental that a patent is presumed to be valid and the burden of establishing invalidity rests on the party asserting it (35 U.S.C. §282). It is well established the presumption of validity is not overcome except by clear and cogent evidence. *Radio Corporation of America* v. *Radio Engineering Laboratories, Inc.*, 293 U. S. 1, 7; *Hazeltine Research, Inc.* v. *Dage Electric Company, Inc.*, 7 Cir., 271 F. 2d 218, 224.

Defendants claim the Patent Office did not consider Singer Patent No. 2,105,015 nor British Patent No. 494,830 of 1938, and also several publications. However, the Singer process is described in British Patent No. 496,866 which was relied upon by the Patent Office during prosecution of the patent. Soap and borax dry-film lubricants are described in Patents No. 2,469,473 and 2,470,062. The former was relied upon as a reference in the Patent Office and the latter is referred to in the body of the specification of the Henricks' patent in suit.

The Patent Examiner had before him as prior art, all of the elements of Henricks' combination and found patentable invention in the combining of these elements. In fact, the Patent Office twice found invention over the prior art, first, when the original patent was granted, and second, when the reissue patent was granted. There is no showing in this case that the most pertinent prior art was not considered by the Patent Office. On the contrary, we think the most pertinent art was cited and was found insufficient to negative patentability.

We cannot sustain the conclusion of law of the trial court that Henricks merely adopted the process which, in view of the prior art, was obvious to persons skilled in the art. The history of Parker Rust Proof Company demonstrates

the process was not obvious. Parker Rust Proof has been a self-proclaimed leader in this field since 1914, but Parker remained uncertain as to how the problem should be solved until some considerable time after the Henricks' invention date.

Dr. Gibson was Technical Director for Parker in 1949 when they decided to develop a lubrication system. Dr. Gibson is now a professor of chemistry and qualified as one "skilled in the art." Parker, in 1949, was operating in the light of the prior art. Dr. Gibson was in charge of this development. They started in "basically with a literature search." They then worked with wet-film lubricants because, as Dr. Gibson testified, "We hadn't realized the true value of drying that particular film." Parker experimented with the formation of an organic film with phosphate as mentioned in the German references. Finally, Parker came to the Henricks' combination which it extolled in its literature as a new development of Parker.

The literature references which Parker now points to as teaching the invention, taught Parker nothing. Neither did the practices at Briggs Manufacturing Company. The substitution of soap and borax dry-film for the wet lubricant in the Singer process was, in fact, not obvious to Parker.

The Henricks' process was not, in fact, obvious to the defendants and the others now associated with them in the defense of this suit. None of them made the substitution of elements in the Singer process which, by hindsight, now appears to them to have been "obvious."

Although the learned trial judge found Claim 4 of the patent in suit to be invalid on all suggested grounds, we are of the view that the closest question in the case is the finding and conclusion of the trial court as to public use. This, in turn, refers to use at Briggs Manufacturing Com-

pany in 1943. All of the evidence on this point, except patentee's own evidence, is contained in depositions. It is apparent from Finding 14 that the Court relied upon the testimony of Tousley and Brown which appeared in depositions.

As the evidence relied on appears in depositions, we are in as good a position as the trial court to examine it and determine for ourselves whether the use at Briggs Manufacturing Company was a public use. *Kiwi Coders Corporation* v. *Aero Tool & Die Works*, 7 Cir., 250 F. 2d 562, 568; *Lenat Corporation* v. *Health-Mor, Inc.*, 7 Cir., 181 F. 2d 855, 857.

The trial court did not hold the combination claimed in the patent in suit was publicly used in its entirety or that the valuable new result flowing from the combination was understood or achieved at Briggs. What the trial court decided was: "While it is arguable that the precise combination and coaction indicated by the patent are not found verbatim in the prior art, one armed with the knowledge of a worker skilled in that field could, the Court believes, have achieved the result covered by Claim 4 of the reissue patent." The trial court further recognized that the patentee in the patent in suit did make a stride forward in the art but apparently thought it was not sufficient to merit a patent monopoly.

There exists a well established rule that to invalidate a patent on the ground of public use, the prior public use must be established by clear and convincing proof.

In *Smith* v. *Hall*, 301 U. S. 216, 233, the Court refers to the rule as ". . . the heavy burden of persuasion which rests upon one who seeks to negative novelty in a patent by showing prior use." In *Radio Corporation of America* v. *Radio Engineering Laboratories, Inc.*, 293 U. S. 1, 7, the Court cites with approval a number of cases for the prop-

osition, the burden of proof is upon the party setting it up and "every reasonable doubt should be resolved against him." Indeed, the late Chief Judge Learned Hand stated the rule in even more emphatic language in *Block* v. *Nathan Anklet Support Co., Inc.*, 2 Cir., 9 F. 2d 311, 313, ". . . but in such cases probability, even extreme probability, is not enough. The proof must be as absolute as in a criminal conviction; indeed, the rule comes nearly to this, that one must have contemporaneous records, verbal or structural."

In June 1943, when Henricks came to the Briggs Manufacturing Company in behalf of the Gilron Products Drawcote, a number of experiments were conducted which led to the changeover from the Singer process to Gilron. Each blank tested was subjected to six consecutive forming operations. Henricks experimentally ran two baskets of blanks with a phosphate undercoat. There were approximately one hundred test pieces in the two baskets, a very small amount considering the large volume being handled. No further notice was taken of the pieces themselves, and they were enveloped in the big flow of material that was in process. The success of the process was in no way there demonstrated. This rather minor incident at Briggs did not lead to the use of the patented combination by Briggs. In fact, Briggs abandoned the use of phosphate entirely. The temporary and almost casual experiment with soap and borax went into the discard.

After the decision in this case by the trial court, Henricks received information that the United States Government Arsenal at Joliet, might have a report which would show the true facts as to the Briggs operation. Inquiry there revealed nothing. The inquiry was forwarded to Frankfort Arsenal. Nothing was found there, but when the inquiry was forwarded to the Record Files in Missouri, a report was located. Henricks was permitted to read the report and make extracts therefrom.

Plaintiffs filed a motion to amend the findings of fact and for a new trial. The Court denied the motion. This was understandable where the Court considered the patent to be invalid on all grounds urged. However, as our view is that the turning point of this case is the question of alleged public use at Briggs, we think the report should have been considered, especially that part which deals with the initial experimentation with the Gilron process. It would appear reasonable that if there had been any significant or more than experimental use of soap and borax over phosphate in cartridge-case manufacture at Briggs, it would surely have appeared in the report which the Briggs officials made to the army ordnance.

Another convincing argument in favor of plaintiffs' contention is that if soap and borax had been applied over phosphate in regular production, there would necessarily have been a tank for phosphate solution and a separate tank for the soap and borax solution arranged in series so that the baskets containing the blanks or workpieces would move successively through the two solutions. There is no claim that any such procedure was followed.

We hold there is no sufficient showing of prior public use and that Claim 4 of the patent in suit is valid. The case will, therefore, be remanded to the District Court for further proceedings consistent with this opinion, as the question of validity only was passed upon in the previous trial.

REVERSED.

UNITED STATES COURT OF APPEALS

For the Seventh Circuit

Chicago 10, Illinois

Wednesday, September 4, 1963.

Before

Hon. F. Ryan Duffy, Circuit Judge.
Hon. Luther M. Swygert, Circuit Judge.
Hon. J. Earl Major, Circuit Judge.

DEVEX CORPORATION, et al., *Plaintiffs-Appellants,* vs. GENERAL MOTORS CORPORATION, et al., *Defendants-Appellees.*	Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.
No. 13979	

IT IS ORDERED by the Court that the petition for a rehearing of this cause be, and the same is hereby, DENIED.

DEVEX CORPORATION, et al.,
Plaintiffs,
vs.
GENERAL MOTORS CORPORATION, et al.,
Defendants.
No. 56C 1912

DEVEX CORPORATION, et al.,
Plaintiffs,
vs.
HOUDAILLE INDUSTRIES, INC.,
Defendant.
No. 57 C 892

ORDER.

AND NOW, it appearing that the above-entitled actions involve a common question of law and or fact, namely, the validity of Claim 4 of U. S. Patent No. Re. 24,017 which claim is the only one involved in either action, it is hereby

ORDERED as follows:

(1) The above entitled actions are consolidated for trial of said common issue of validity, but not otherwise, and said common issue will be tried first.

(2) Immediately following the conclusion of said consolidated trial on the common issue of validity; the issue of infringement within the Northern District of Illinois by General Motors Corporation as it relates to the issue of venue of that Defendant will be tried in Civil Action No. 56 C 1912.

(3) The issue of infringement within the Northern District of Illinois by defendant General Motors Corporation in Civil Action No. 54 C 1912 will first be decided by this Court in order that the issue of venue of that defendant may be determined prior to the rendering of any decision on the issue of validity with respect to defendant General Motors Corporation. ~~*(In the event this Court holds that venue of the defendant General Motors Corporation does not exist in the Northern District of Illinois, no decision on the issue of validity will be applicable to defendant General Motors Corporation.)*~~

(4) Prior to trials, if any, on the issue of infringement by defendant Metal Lubricants Co. in Civil Action No. 56 C 1912 and the issue of infringement in Civil Action No. 57 C 892, the Court will render its decision on the common issue of validity.

(5) The issue of infringement in Civil Action No. 57 C 892, if tried, shall not be tried until after decision by this Court on both the issues of validity and infringement have been decided in Civil Action No. 56 C 1912.

(6) All parties in both suits shall be given common notices on matters of discovery and depositions relating to the issue of validity; however, depositions and discovery on the issues of infringement shall be conducted separately as to each of the defendants in both suits.

EDWIN A. ROBSON,
United States District Judge.

Entered: November 19, 1959.

Office-Supreme Court, U.S.
FILED
DEC 7 1963
JOHN F. DAVIS, CLERK

In the Supreme Court of the United States

OCTOBER TERM, 1963.

No. 618.

GENERAL MOTORS CORPORATION, METAL LUBRICANTS CO., HOUDAILLE INDUSTRIES, INC.,

Petitioners,

vs.

DEVEX CORPORATION, WILLIAM C. McCOY, THEODORE A. TeGROTENHUIS,

Respondents.

BRIEF IN OPPOSITION TO THE PETITION.

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December 5, 1963.

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In the Supreme Court of the United States

OCTOBER TERM, 1963.

No. 618.

GENERAL MOTORS CORPORATION, METAL LUBRICANTS CO., HOUDAILLE INDUSTRIES, INC.,

Petitioners,

vs.

DEVEX CORPORATION, WILLIAM G. McCOY, THEODORE A. TeGROTENHUIS,

Respondents.

BRIEF IN OPPOSITION TO THE PETITION.

COUNTER-STATEMENT.

(a) These are ordinary patent infringement cases. The judgment sought to be reviewed* is not final or "final except for accounting"; 28 U. S. C. 1292(4). The cases were consolidated for trial on the common issue of validity under Rule 42(a) F. R. C. P. and validity is the only issue which has been tried to date (Pet. 37). All issues of infringement are to be tried subsequently and separately (Pet. 5).

(b) PETITIONERS' QUESTION 1 (Pet. 2-3): There was no anticipating prior public use at Briggs (Pet. 9-13). The Court of Appeals was correct as a matter of law in holding that petitioners did not meet their burden of proof

* The petition does not comply with Rule 23(1)(j) of this Court in that no copy of the judgment of the Court of Appeals is appended.

(Pet. 35-6) and in holding, on undisputed evidence, that what happened at Briggs was so transitory, fortuitous and trivial in its nature and extent that it did not constitute a prior use within the meaning and intent of 35 U. S. C. 102(a) (Pet. 36).

Contrary to petitioners' assertions and to the thrust of Question 1, the Court of Appeals did not bottom its rejection of the Briggs defense on the Henricks affidavit. It dealt first with the failure of petitioners' proofs and the insufficiency of the alleged use as an anticipation under 35 U. S. C. 102 (Pet. 35-6). It then went on to say that the District Judge should have considered the affidavit (Pet. 37); it was manifestly proper for the Court of Appeals to emphasize, in this fashion, the failure of petitioners to meet their burden of proof.

Question 1 is purely academic: the petition nowhere proffers or asserts any facts which would lead to a different result if the case is remanded to the District Court for a new trial. Nor did petitioners do so in either of the courts below.

(c) PETITIONERS' QUESTION 2 (Pet. 3): Petitioners' assertion that the accused process "operates in a manner and with a result directly contrary to" the patented process (Pet. 11, 15-7) is untrue. The specific question—hardly one for review by this Court—is whether the use and manner of use of chemical compositions supplied to petitioners by Parker Rust Proof Company (which is defending the action; Pet. 31) for lubricating the work pieces and the dies in a metal-forming operation, leaves a coating on the formed piece which can be removed by ordinary cleaning methods (as respondent proved) or whether the coating is insoluble (as petitioners assert).

Petitioners' assertion is directly contrary to Parker Rust Proof's published technical specifications and the admissions of petitioners' expert witness at the trial (Ptf. App. 57, 66). Petitioners' only argument for indefiniteness is therefore ill founded in fact and the Court of Appeals was right in holding that the claim meets the requirements of 35 U. S. C. 112 (Pet. 31-2).

(d) PETITIONERS' QUESTIONS 3 AND 4 (Pet. 3-4): None of the thirty-one references relied upon by Petitioners anticipate the patent in suit (Pet. 32). The acts at Briggs were those of the patentee himself and therefore no question of inventorship arises. Question 3 is redundant and does not present any question additional to those presented by Questions 1 and 4.

The trial court recognized that the patent in suit did make a stride forward in the art but apparently thought it was not sufficient to merit a patent (Pet. 35). The Court of Appeals reviewed the history of the art in general (Pet. 26-9) and of Parker Rust Proof in particular (Pet. 33-4); pointed to undisputed evidence showing that Henricks had achieved new, valuable and unexpected results (Pet. 30-1); noted that despite the aid given to Parker Rust Proof by its own competitors (Pet. 31) no better art than that considered by the Patent Office had been found (Pet. 33-4) and that the process had not in fact been "obvious to the defendants and the others now associated with them in the defense of this suit" (Pet. 33-4); and on these facts, all established by undisputed evidence, properly held that all requirements for patentability under 35 U. S. C. 103 had been met.

ARGUMENT.

The "Questions Presented," on their face, are not questions of the sort which should or need be considered by this Court; Rule 19(1)(b); *Magnum Import Co. v. Coty* (1923) 262 U. S. 159, 163; *Layne & Bowler Co. v. Western Well Works*, (1923) 261 U. S. 387, 392-3; *Forsyth v. Hammond* (1897) 166 U. S. 506, 513-4. The matters hereinabove recited plainly show that the Questions are contrived ones which do not actually arise in the case.

What petitioners are really seeking is not a resolution of an unsettled or uncertain question of law or even the resolution of a factual question of general public importance but merely a second review of contentions apposite only to the particular circumstances of this case; *Keller v. Adams-Campbell Co.*, (1924) 264 U. S. 314, 319-20; *Tyrrell v. District of Columbia*, (1917) 243 U. S. 1, 6; *Furness, Withy & Co. v. Yang-Tsze Insurance Association*, (1917) 242 U. S. 430, 433-4; *United States v. Rimer*, (1910) 220 U. S. 547, 548.

The petition should be denied.

Respectfully submitted,

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December 5, 1963.